

DEC 08 2005

SIMTEK6140


IN THE UNITED STATES PATENT OFFICE

In re Application of
Tomitaka Yamashita

App. No.: 09/681430
Filed: 4/3/2001
Conf. No.: 4775
Title: ROTATING ELECTRICAL MACHINE
Examiner: L. Pham
Art Unit: 2834

I hereby certify that this correspondence and all
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December 8, 2005


Ernest A. Beutler
Reg. No. 19901

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

APPELLANT'S BRIEF

In response to the Notice, dated December 6, 2005, first objecting to the Brief, filed June 4, 2005, please substitute this Brief for that previously filed.

REAL PARTY IN INTEREST

In addition to the appellant, the real party in interest is his assignee, Kabushiki Kaisha Moric, a Japanese company.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences that would have a bearing on or be affected by the decision in this appeal.

STATUS OF CLAIMS

Claims 1 through 35 remain in this application. Claims 1-26 have been allowed. The rejections of claims 27 through 35 has been appealed and these claims are all before the Board.

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STATUS OF AMENDMENTS

This case has been Briefed once already and in response to the previous brief the Examiner had reopened prosecution. In response to the first Brief, filed by fax on July 3, 2003, appealing the rejections of all claims, the Examiner reopened prosecution and again rejected all claims, more than 4 months later on November 4, 2003. However the Examiner's rejection was based on claims no longer under prosecution as an amendment previously filed had not been entered. In response to that Non Final Rejection, applicant filed an amendment on July 21, 2004, to which the Examiner replied by allowing claims 1-26 and rejecting the remaining claims on October 7, 2004. That was responded to by a proposed Amendment filed December 4, 2004. That was not responded to until a mailing dated April 6, 2005 and to avoid abandonment applicant file a Notice of Appeal. Applicant has submitted a second proposed amendment to try to overcome the Examiner's technical rejections but each has been refused entry as raising "new issues" even though they would have reduced the issues on appeal by overcoming trivial technical objections. Thus the claims before the Board are as Finally Rejected. A clean copy of the appealed claims appears in the Appendix to this Brief.

SUMMARY OF CLAIMED SUBJECT MATTER

Claim 27 is the only independent claim before the Board and it is set out below in annotated form to indicate the reference numerals used to identify the claimed elements in the drawings and specification and to indicate the paragraphs where the illustrated embodiment of FIGS 1-3 is described. Most of the claims read on this embodiment, except as will be hereinafter described.

27. (Annotated) A DC rotating electrical machine (indicated generally by the reference numeral 21 and described first in Paragraph [0031]) comprised of an outer housing(indicated generally by the reference numeral 22 and described first in Paragraph [0034]) forming a stator of said DC rotating electrical machine, said outer housing being comprised of a generally cylindrical center section (indicated generally by the reference numeral 35 and described first in Paragraph [0035])closed at opposite ends by first (indicated by the reference numeral 23 and described first in Paragraph [0034])and second (indicated by the reference numeral 36 and described first in Paragraph [0036])end closures, a rotor (indicated generally by the reference numeral 39 and described first in Paragraph [0036])within said outer housing and extending through said first end closure for driving connection to a related rotating machine (indicated generally by the reference numeral 34 and described first in Paragraph [0034]), said second end closure carrying a cylindrical post (indicated by the reference

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numeral 38 and described first in Paragraph [0034])extending into a cylindrical opening (unnumbered but described first in Paragraph [0036])in said rotor for journaling said rotor within said outer housing.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

There are technical objections to the disclosure which will be discussed in the ARGUMENTS section of this brief.

The art rejections before the Board are the rejection of claims 27-29 and 35 under 35 USC 103(a) on US Patent 5,876,298 (Kato) in view of US Patent 6,163,093 (Shimizu et al).

The rejection of claims 30 and 32-33 under 35 USC 103(a) on the Kato, Shimizu et al combination in further view of US Patent 5,644,180 (Buchanan).

The rejection of claims 31 and 34 under 35 USC 103(a) on the Kato, Shimizu et al combination in further view of US Patent 6,246,137 (Obara).

APPELLANT'S ARGUMENTS

THE REJECTION UNDER 35 USC 112

The Examiner has rejected claim 27 under 35 USC 112 on the basis that the disclosure does not illustrate the passage of the rotor shaft "through" the end closure 23. Appellant's attorney made both a formal and informal attempts to change the claim language to address this rejection, even though he felt it was not well taken. However each attempt was rebuffed on the basis that the Examiner felt that new issues were being raised. Therefore it must be assumed from this position that the Examiner believes that this limitation is not met by the art of record. How else could the proposal to incorporate language from dependent claims constitute "new issues"?

Merriam Webster on line dictionary defines through as follows: "used as a function word to indicate movement into at one side or point and out at another and especially the opposite side of <drove a nail *through* the board>". This is exactly what is shown in FIG. 3 where the rotor shaft passes through the portion of the closure 23 that closes the end of the motor cavity.

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THE REJECTION ON THE KATOU SHIMIZU ET AL COMBINATION

However even ignoring this important limitation, the Examiner agrees that Kato et al alone does not anticipate even claim 27 since it fails to show the supporting post for the rotor shaft. Therefore the Examiner suggests that it would be obvious to modify Kato et al in light of Shimizu et al's teaching. This is an obvious attempt to combine references in light of appellant's teaching not that of the art of record. It should be noted that appellant's object, as described in paragraphs [0004] and [0005] is intended to provide a very compact and yet heavy duty bearing arrangement.

Contrast this with the bearing arrangement shown in the secondary reference the Examiner proposes to substitute. Shimizu et al shows a pump drive wherein the pump drive end 13 is supported by three heavy duty bearings 29, 30 and 31. The Examiner, however, proposes to utilize only the lightly loaded end bearing 28. This would weaken not strengthen Kato et al's structure. Thus it is most respectfully submitted that the combination is not one skilled in the art would make.

Claim 28 depends on claim 27 and still further distinguishes over Shimizu et al's teaching in calling for the supporting post "extends a substantial distance axially into the rotor". The Examiner says this is true, but even a casual inspection shows otherwise.

THE REJECTION ON THE KATOU, SHIMIZU ET AL AND BUCHANAN COMBINATION

Claims 30 depends through claim 29 upon claim 28 and claim 32 depends upon claim 27 and further define the bearing as being "an oil impregnated, sleeve type bearing". Interestingly the Examiner has alleged that this is not shown in appellants drawings. It is shown, for example in FIGS. 3 and 4 and described as such in Paragraph [0036].

The Examiner attempts to meet this limitation by stretching his already tenuous combination by proposing to employ the obviously light duty bearing of Buchanan. It is most respectfully submitted that the Examiner is attempting to reconstruct appellant's construction from bits and pieces of the prior art absent any teaching of the art to support the combination.

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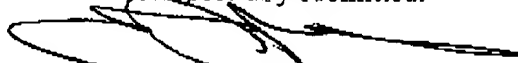
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SUMMARY

It is submitted for the foregoing reasons that the Examiner has failed to make out a prima facie case of Obviousness and that by suggesting that proposed claim amendments that only recited limitations already present in the claims raised "new issues" that the Examiner has himself admitted that the cited art does not anticipate the claim language. Reversal of all grounds of rejection is therefore respectfully requested.

It is also submitted that no Brief Fee is required for this brief as the brief fee was paid in the earlier appeal of this case.

Respectfully submitted:



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**APPENDIX
CLEAN COPY OF CLAIMS ON APPEAL**

27.A DC rotating electrical machine comprised of an outer housing forming a stator of said DC rotating electrical machine, said outer housing being comprised of a generally cylindrical center section closed at opposite ends by first and second end closures, a rotor within said outer housing and extending through said first end closure for driving connection to a related rotating machine, said second end closure carrying a cylindrical post extending into a cylindrical opening in said rotor for journaling said rotor within said outer housing.

28.A DC rotating electrical machine as set forth in claim 27 wherein the cylindrical post extends a substantial distance axially into the rotor.

29.A DC rotating electrical machine as set forth in claim 28 wherein the cylindrical post engages a bearing associated with the rotor.

30.A DC rotating electrical machine as set forth in claim 29 wherein the bearing associated with the rotor comprises an oil impregnated, sleeve type bearing.

31.A DC rotating electrical machine as set forth in claim 29 wherein the bearing associated with the rotor comprises an anti friction bearing.

32.A DC rotating electrical machine as set forth in claim 27 wherein the cylindrical post is detachably connected to the second end closure.

33.A DC rotating electrical machine as set forth in claim 32 wherein the bearing associated with the rotor comprises an oil impregnated, sleeve type bearing.

34.A DC rotating electrical machine as set forth in claim 32 wherein the bearing associated with the rotor comprises an anti friction bearing.

35.A DC rotating electrical machine as set forth in claim 27 wherein the cylindrical post is integrally formed with the second end closure.

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**COPIES OF EVIDENCE SUBMITTED
AND RELIED UPON BY APPELLANT**

None

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COPIES OF DECISIONS
IN RELATED APPEALS AND INTERFERENCES

None